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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,231	06/27/2000	Markus Pompejus	BGI-122CP	4162

959 7590 04/05/2002

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BOSTON, MA 02109

EXAMINER

MONSHIPOURI, MARYAM

ART UNIT	PAPER NUMBER
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1652

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DATE MAILED: 04/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/604,231

Applicant(s)  
Pompejus et al.

Examiner  
Maryam Monshipouri

Art Unit  
1652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 9-17, 25-33, and 39 is/are pending in the application.
- 4a) Of the above, claim(s) 25-33 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 9-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☒ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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Applicant's response to restriction requirement filed 2/2002 (Paper # 8) is acknowledged. Applicant elected Group I invention (claims 1-2 and 9-17) directed to SEQ ID NO:1 with traverse. Claims 3-8, 20-24 and 34-38 are canceled.

In traversal of restriction requirement applicant argues that the policy set forth in 1192 O.G. 68(Nov. 19, 1996) clearly provides that a reasonable number of sequences re allowed to be claimed in a single application. Further it has been determined that "normally ten sequences constitute a reasonable number for examination purposes". Hence, applicants respectfully request that 10 sequences be examined in the instant application. Further, according to applicant a species election for searching purposes would bo more proper in this situation. This is because a sufficient search and examination with respect to the claimed nucleotides can be made without serous burden on the examiner.

These arguments were fully considered but were found unpersuasive. This is because it is true that a reasonable number of sequences are allowed to be claimed in a single application and that normally up to ten sequences in some cases can constitute a reasonable number for examination purposes. However, This policy is case dependent. Usually, in cases where up to ten sequences are searched together without undue burden of searching, said sequences are directed to different species. As stated in the previous office action, the sequences claimed here are directed to independent inventions (i.e. products of unrelated structure and function) not different species of a single invention and for the reasons set forth previously s well as those provided

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below each invention requires an independent search which is **not coextensive** with those of other inventions.

Applicant's attention is drawn to table 1, of the specification where the characteristics of each sequence is mentioned. For example, SEQ ID NO:1, 5 and 7 are directed to sequences encoding proteins of different structure with: sucrose-permease IIABC component; beta-glucosidase-permease component and fructose-specific IIBC component etc., implying the involvement of each protein in transport of different products such as sucrose, glucose and fructose, respectively (i.e. different function). Thus, in contrast to applicant's view, treating claimed sequences as different species (i.e. products of either common structure or common function) of a single invention and thereby rejoining all ten sequences is improper because it imposes an undue burden of searching on the examiner.

Finally, for the reasons set forth above in addition to those provided previously, restriction is maintained according to previous office action and is hereby made **Final**.

#### **DETAILED ACTION**

Claims 1-2 and 9-17 directed to elected SEQ ID NO:1 invention are under examination on the merits. Claims 25-33, 39 and SEQ ID NO:5, 7, 15, 17, 21, 23, 25, 27 and 29 are withdrawn as drawn to non-elected invention.

#### ***Claim Objections***

1. Claims 1-2 and 16 are objected to because of the following informalities: these claims are generic. Applicant is advised to amend the claims to recite only the elected invention and

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transport systems (claim 2) and fine chemicals (claim 12) which are relevant to the elected invention. Appropriate correction is required.

2. *Claim Rejections - 35 USC § 112*

3. The following is a quotations of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2 and 9-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “ or a porion thereof” in claim 1 (and its dependent claims 2 and 10-17) as well as claim 9 is vague and indefinite because it appears to be redundant. Claim 1 as written requires that both corynebacterium glutamicum phosphopyruvate: sugar phosphotransferase system (PTS) protein and “a portion thereof” comprise SEQ ID NO:1. Thus, it is not clear what is the difference between said products. **For examination purposes it is assumed that “a portion thereof “must comprise SEQ ID NO:1.**

5. Claim 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “ from l” in claim 15 and its dependent claim 16 is confusing. Usually whether a product is retained inside or excreted from a cell it should first be made **in** a cell. If

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applicant means a fine chemical excreted from the cell, he/she is advised to rewrite said claim.

Otherwise it is suggested to replace the term "from" with "in" in order to avoid confusion.

**No claim is allowed.**

*Allowable Subject Matter*

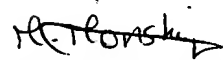
SEQ ID NO:1 is free of prior art. Further the prior art does not teach or suggest preparing such specifically claimed sequence. Hence said sequence is also non-obvious.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Maryam Monshipouri, Ph.D. whose telephone number is (703) 308- 1083.

The Examiner can normally be reached daily from 8:30 A.M. to 5:00 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. P. Achutamurthy, can be reached at (703) 308-3804. The OFFICIAL fax number for Technology Center 1600 is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.



Maryam Monshipouri, Ph.D.

Patent Examiner